

## **REMARKS**

Claims 1-51 are pending in the instant application. Claims 1-51 have been rejected by the Examiner.

By the above amendments, Claims 1 and 26 have been amended to more particularly point out and distinctly claim the subject matter which Applicants regard as the invention. More specifically, Claims 1 and 26 have been amended to narrow the first organic solvent and the second organic solvent to other than t-butyl methyl ether (MTBE) or tetrahydrofuran (THF). Support for the amendments may be found in the specification on page 14, lines 15-20 and page 18, lines 27-32. Applicants submit that the amendments are fully supported by the specification as filed, and no new matter is being added. By the above amendments, Claims 22-25 and 48-51 have been cancelled without prejudice. Applicants maintain that the amendments canceling Claims 22-25 and 48-51 are being made solely to advance the prosecution of the instant application and are not in any way to be construed as an admission that the canceled material is unpatentable. Thus, Applicants reserve the right to pursue coverage of the canceled material by filing a continuation or a divisional application at an appropriate time in the future. After entry of the amendments, Claims 1-21 and 26-47 will remain pending and under consideration.

Claims 1-5, 7-10, 12-16, 26-30, 32-35 and 37-41 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by Maryanoff et al., US Patent 5,387,700. More specifically, the Examiner states Maryanoff et al., US Patent 5,387,700 "... discloses the instant 2-step process of making the sulfamates .... The solvents for each of the 2-steps are the same as applicants. See t-butyl methyl ether or tetrahydrofuran ...." Further the Examiner states that "Applicants' process does not differ from this in that it is specified as being continuous."

Applicants respectfully traverse the rejection. Applicants respectfully refer the Examiner to the above amendments which have limited the continuous process of the

present claims to a continuous process wherein the first organic solvent and the second organic solvent are other than t-butyl methyl ether (MTBE) or tetrahydrofuran (THF). In view of the amendments, Applicants submit that the teachings of Maryanoff et al., US Patent 5,387,700, do not anticipate the instant claims. Applicants therefore respectfully request that the Examiner withdraw the rejection of Claims 1-5, 7-10, 12-16, 26-30, 32-35 and 37-41 under 35 U.S.C. §102(b).

Claims 22-25 and 48-51 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by Maryanoff et al., US Patent 5,387,700. The Examiner states that "This patent produces the same compounds as made in the instant case .... Product-by-process claims are construed as being product claims."

Applicants respectfully refer the Examiner to the above amendments canceling Claims 22-25 and 48-51 without prejudice which renders the rejection moot. Applicants respectfully request that the rejection of Claims 22-25 and 48-51 under 35 U.S.C. §102(b) be withdrawn.

Claims 1-21 and 26-47 have been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Maryanoff et al., US Patent 5,387,700. The Examiner states "...it is obvious that it is desireable to make the process as continuous as possible and this expedient is considered to be obvious to one of ordinary skill in the art."

Applicants respectfully traverse the rejection. Applicants submit that Maryanoff et al., in US Patent 5,387,700, do not teach or suggest the continuous process of the present invention wherein step (A) is completed in a first organic solvent and step (B) is completed in a second organic solvent which is at least the solvent of step (A) and wherein neither the first organic solvent nor the second organic solvent are methyl t-butyl ether (MTBE) or tetrahydrofuran (THF). Further, Maryanoff et al., in US Patent 5,387,700, in the Examples and specification, suggest that the isolation and stabilization of the chlorosulfate intermediate is preferred (see, e.g., column 3, lines 29-34; and column 4, lines 57-66) and that the preferred solvent of the first step (toluene) and the preferred solvent of the second

step (THF) are different (*see, e.g.*, column 2, line 55 through column 3, line 25). Thus Applicants submit that the teachings of Maryanoff et al. would not motivate one skilled in the art to run the two-step process of the present invention in a continuous manner wherein step (A) is completed in a first organic solvent and step (B) is completed in a second organic solvent which is at least the solvent of step (A) and wherein neither the first organic solvent nor the second organic solvent are THF or MTBE.

Applicants further submit that although it may be desirable to make a process continuous, it does not necessarily and inevitably follow that a step-wise process can be run in a continuous manner. Applicant submits that, at most, the teaching in Maryanoff et al, US Patent 5,387,700, might make it obvious to try to run the 2-step process disclosed therein in a continuous manner. However, obvious to try is an improper basis for a § 103(a) rejection when there is no suggestion or expressed expectation of success in the prior art that would have led one to perform the experimentation in the first place. Although obviousness does not require absolute predictability, a reasonable expectation of success is necessary.

Applicant urges that in the instant case, there was no reasonable expectation of success that the 2-step process disclosed in Maryanoff et al. could be run in a continuous manner. Since the Examiner has failed to make a prima facie case of obviousness, Applicant respectfully requests that the Examiner withdraw the rejection of Claims 1-21 and 26-47 under 35 USC § 103(a) over Maryanoff et al., US Patent 5,387,700.

In view of the above amendments and comments, Applicants maintain that Maryanoff et al., in US Patent 5,387,700, do not render the continuous process of the present invention obvious, and Applicants therefore respectfully request that the rejection of Claims 1-21 and 26-47 under 35 U.S.C. §103(a) over Maryanoff et al. be withdrawn.

Applicants maintain that the application is in condition for allowance and passage to issue is earnestly requested.

Respectfully submitted,

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